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EXAMINER

ZURITA, JAMES H

ART UNIT

PAPER NUMBER

3625

NOTIFICATION DATE

DELIVERY MODE

12/03/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

pto-sl@huschblackwell.com

DETAILED ACTION

Response to Amendment

On 07/17/09, applicant cancelled claims 2, 7, 10, 14 and 19-20. Applicant added claims 24-43. Applicant amended claims 1, 3-6, 8, 9, 11-13, 15-18.

Claims 1, 3-6, 8-9, 11-13, 15-18 and 21-43. Of these, claims 21-23 are withdrawn from prosecution as being directed to a non-elected invention.

Claims 1, 3-6, 8-9, 11-13, 15-18 and 24-43 will be examined. Claims 1, 35 and 43 are independent.

Response to Arguments

Applicant's arguments filed 07/17/09 have been fully considered.

Objections and rejections are withdrawn in view of amendment.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 35 and 43 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Based on Supreme Court precedence see *Diamond v Diehr* 450 US 175,184 (1981); *Parker v. Flook*, 437 US 584,588,n. 9 (1978); *Gottschalk v Benson*, 409 US 63, 70 (1972); *Cochrane v Deener*, 94 US 780, 787-88 (1876) a 101 process must (1) be tied to another statutory class (such as an apparatus) or transform underlying subject

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matter (such as an article or materials) to a different state or thing. Since neither of these requirements is met by the claim the claim is rejected as being directed to non-statutory subject matter.

The Examiner suggests the following amended language to correct the claims:

1. A method for coordinating non-matching patterns on selected items developed from placing design features on the selected items by a computer in a particular manner comprising:

Identifying by the computer at least one item;

Selecting by the computer at least two different design features for use in developing non-matching patterns for placement on the at least one identified item;

Placing by the computer at least one of the at least two different selected design features on at least one of at least two of the identified item and placing the other of said two different selected design features on the other of said at least two of the identified item to form at least one pattern on each such item; and

Coordinating by the computer the placement of the selected design features on at least two of the identified items such that the at least one pattern formed on one such item is non-matching when compared to the at least one pattern formed on each of the other items.

35. A method for coordinating dissimilar patterns on selected items developed from placing design features on the selected items by a computer in a particular manner comprising:

identifying by the computer at least one item;

selecting by the computer at least two different design features for use in developing dissimilar patterns for placement on the at least one identified item;

placing by the computer at least one of the two different selected design features on at least one of the at least two of the identified item and placing the other of said at least two different selected design features on the other of said at least two of the identified item to form at least one pattern on each such item; and

coordinating by the computer the placement of the selected design features on at least two of the identified items such that the at least one pattern formed on one such item is dissimilar to the at least one pattern formed on each of the other items.

43. A method for coordinating variegated patterns on selected items developed from placing design features on the selected items by a computer in a particular manner comprising:

Identifying by the computer at least one item;

Selecting by the computer at least two different design features for use in developing variegated patterns for placement on the at least one identified item;

Placing by the computer at least one of the at least two different selected design features on one of at least two of the identified item and placing the other of said at least two different selected design features on the other of said at least two of the identified item to form at least one variegated pattern on each such item; and

Coordinating by the computer the placement of the selected design features on at least two of the identified items such that the at least one variegated pattern formed on

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one such item is dissimilar to the at least one variegated pattern formed on each of the other items.

Claim Objections

Claims 3-6, 8-9, 11-13, 15-18, 24-34 and 36-43 are objected to as being dependent from rejected claims 1, 35 and 43.

Allowable Subject Matter

Claims 1, 3-6, 8-9, 11-13, 15-18 and 24-43 would be allowable if rewritten to overcome all rejections and objections raised herein.

The following is an examiner's statement of reasons for indicating allowable subject matter.

Applicant's arguments and amendments are commensurate with the disclosures as filed. Applicant's amendment to the specifications is particularly helpful in defining his invention. See paragraph 0137, amendment of 07/17/2009, pages 4-5. Updated searches were performed using the amended claims language.

The closest US prior art, Feld, US 2001/0026272, neither anticipates nor renders obvious the combination, *inter alia* of representative claim 1:

Identifying at least one item;

Selecting at least two different design features for use in developing non-matching patterns for placement on the at least one identified item;

Placing at least one of the at least two different selected design features on at least one of at least two of the identified item and placing the other of said two different selected design features on the other of said at least two of the identified item to form at least one pattern on each such item; and

Coordinating the placement of the selected design features on at least two of the identified items such that the at least one pattern formed on one such item is non-matching when compared to the at least one pattern formed on each of the other items.

The closest Non-patent literature is

Tina Cassidy, Making Waves, Boston Globe, Boston, May 2, 2002, downloaded from ProQuest Direct on the Internet on March 4, 2009, 4 pages.

Also of interest are the following:

Jennifer Frey, Deion's DC Duds, Washington Post, 7 June 2000, downloaded from ProQuest Direct on the Internet on 4 March 2009, 6 pages.

Laura Liebeck, 1994 Power Brands, Discount Store News, New York, 10/03/1994, downloaded from ProQuest Direct on the Internet on 4 March 2009, 25 pages.

Judy Hevrdeis, 5 that annoy, 5 that would ensure joy, Knight Ridder Tribune News Service, Washington, March 10, 1994, downloaded from ProQuest Direct on the Internet on 4 March 2009, 2 pages.

Terri Finan, Thinking Outside the Box, Club Management, St. Louis, Jul/Aug 1999, vol 78, Issue 4, page 85, downloaded from ProQuest Direct on the Internet on 4 March 2009, 5 pages.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES ZURITA whose telephone number is (571)272-6766. The examiner can normally be reached on 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on (571)272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James Zurita/
James Zurita
Primary Examiner
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22 November 2009